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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85468736
Applicant	Personal Liberty Media Group, LLC
Applied for Mark	PERSONAL LIBERTY DIGEST
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of)	
)	
Personal Liberty Media Group, LLC)	
)	
For: PERSONAL LIBERTY)	Attorney: James MacFarlane
)	
Serial No. 85/468,795)	
)	
PERSONAL LIBERTY DIGEST)	
)	
Serial No. 85/468,736)	
)	
Filed: November 9, 2011)	

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Commissioner for Trademarks
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APPLICANT'S REPLY BRIEF

The Examiner states that “personal liberty” refers to “the freedom of the individual to do as [s]he pleases limited only by the authority of politically organized society to regulate [his] action to secure the public health, safety, or morals or of other recognized social interests.” *See* page 3 of Examiner Appeal Brief. In view of this definition of “personal liberty,” the Examiner succinctly articulates his position for refusing registration of the PERSONAL LIBERTY and PERSONAL LIBERTY DIGEST when he writes,

As noted above, applicant's goods and services consist of newsletters in the fields of current events, economics, politics, wealth management and personal management. Its goods and services thus concern "personal liberty," namely *the freedom of people generally to do as they please, within those contexts.*" (emphasis added).

This statement sheds light on two shortcomings of the Examiner's analysis.

First, applying the Examiner's logic, the marks PERSONAL LIBERTY and PERSONAL LIBERTY DIGEST are merely descriptive of any and all goods and services that relate to any field of human endeavor since the freedom of people to *do* as they please applies to essentially all legal human activities. Following the Examiner's logic there is essentially no *context* involving the action of humans that is not encompassed by the meaning of "personal liberty." Thus, the Examiner can refuse registration of any mark that includes the phrase "personal liberty" simply by selecting the appropriate *context*. For example, applying the Examiner's logic, "personal liberty" is merely descriptive of providing a website and newsletter featuring information in the fields of photography (a freedom protected by the First Amendment to the Constitution), fishing (a freedom guaranteed by the constitution of several U.S. states) and elementary school education, since these fields of human endeavors refer to activities of people in which they have the freedom to act, subject to certain limitations. In short, the Examiner has misconstrued the meaning of "personal freedom" too broadly and thereby has interpreted the phrase to encompass the fields of economics, politics, wealth management and personal management even though the definition offered by the Examiners fails to refer to any one of these fields.

Second, this statement by the Examiner reinforces Applicant's argument that the PERSONAL LIBERTY and PERSONAL LIBERTY DIGEST marks require interpretation by consumers since the marks do not immediately tell an average potential purchaser what the

goods or services are. *See In re The Gracious Lady Service, Inc.*, 174 USPQ 340 (TTAB 1972)(if a trademark does not, without interpretation and imagination, describe the goods or services, then the trademark is not merely descriptive.). As such, a prospective purchaser must interpret the marks in an attempt to ascertain the goods and services represented by the marks. Hence, Applicant's marks are at most suggestive of Applicant's goods and services. A mark is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods and services. *See Stix Products, Inc. v. United Merchants & Mfrs. Inc.*, 295 F. Supp. 479, 160 USPQ 777 (S.D.N.Y. 1968).

Lastly, as stated in Applicant's Appeal Brief, when there is any doubt as to registrability, all doubt must be resolved in favor of Applicant, and registration of the trademark should be allowed. *See In re The Stroh Brewery Co.*, 34 USPQ 2d 1796 (TTAB 1995). Thus, relevant authority teaches that any reasonable doubt in determining whether the applied-for mark should be classified as merely descriptive or suggestive is to be resolved in favor of applicant, because anyone who believes they may be damaged by registration of a merely descriptive mark may file a notice of opposition. As the Federal Circuit remarked in one case: "It is incumbent on the Board to balance the evidence of public understanding of the mark against the degree of descriptiveness encumbering the mark, and to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent. *In re Merrill Lynch, Pierre, Fenner, and Smith, Inc.* 828 F.2d 1567, 1571, 4 USPQ2d 1141, 1144 (Fed. Cir, 1987); *see also In re Aid Laboratories, Inc.*, 221 USPQ 1215, 1216 (TTAB 1983) (resolving doubt in favor of applicant in finding applied-for mark to be suggestive and entitled to registration on the Principal Register); *In re Conductive Systems, Inc.*, 220 USPQ 84, 86 (TTAB 1983) (recognizing that any doubts regarding the classification of an applied-for mark as merely descriptive or suggestive "are to

be resolved in favor of applicants."); *In re Ray McDermott & Co., Inc.*, 170 USPQ 524, 525 (TTAB 1971) (doubt on question of whether the applied-for mark is merely descriptive should be resolved in applicant's behalf); *In re Pennwalt Corp.*, 173 USPQ 317, 319 (TTAB 1972) (doubt as to whether applied-for mark is merely descriptive should be resolved in applicant's behalf and the mark published for opposition "thereby enabling any person who believes that he would be damaged by the registration of said mark to present evidence to that effect not present herein,"); *In re Gourmet Bakers, Inc.*, 173 USPQ 565, 565 (TTAB 1972) (doubt in determining whether applied-for mark should be classified as merely descriptive or suggestive is resolved in favor of applicant on the theory that any person who believes that he would be damaged by the registration will have an opportunity under [Lanham Act] Section 13 to oppose the registration of the mark and to present evidence, usually not present in the ex parte application, to that effect.").

In the present case, doubt as to the descriptiveness of the applied for marks PERSONAL LIBERTY and PERSONAL LIBERTY DIGEST is evidenced by (1) the multitude of meanings for the words "personal" and "liberty," and thus its need for interpretation by consumers, (2) differences between various definitions of the phrase "personal liberty," which evidences that the phrase is, in fact, interpreted to have different meanings, and (3) the fact that the Trademark Office has allowed numerous trademarks on the Principal Register using the term "liberty" in connection with information and/or educational services related to current event, economics, wealth management and/or politics and wealth management and/or financial planning services, all without requiring a showing of distinctiveness under § 2(f) or disclaimer of the term "liberty". Additionally, doubt as to the descriptiveness of the applied for marks PERSONAL LIBERTY and PERSONAL LIBERTY DIGEST is strongly evidenced by the fact that both applications for

the applied-for marks were approved for publication by the Examiner before an Office action was issued under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

CONCLUSION

Based on the above, it is clear that applicant's mark PERSONAL LIBERTY is not merely descriptive of applicant's goods and services. Therefore, applicant respectfully requests that the examining attorney reconsider and withdraw the refusal to register.

Publication is respectfully requested.

Respectfully Submitted,

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